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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/043,277 Confirmation No. : 4705
First Named Inventor : Karl-Heinz BAUMANN
Filed : January 14, 2002
TC/A.U. : 3616
Examiner : Laura B. ROSENBERG

Docket No. : 225/50754
Customer No. : 23911

Title : SUPPORT STRUCTURE FOR A VEHICLE WITH ATTACHED
FITTING AND METHOD OF MAKING SAME

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APPEAL BRIEF

Sir:

On August 10, 2004, Appellants appealed to the Board of Patent Appeals from the final rejection of Claims 39, 42, 58, and 61. The following is Appellants' Appeal Brief submitted pursuant to 37 C.F.R. §41.37.

The Commissioner is hereby authorized to charge the \$500.00 appeal brief fee, along with any other requisite fees, to Deposit Account 05-1323 (Docket No. 095309.50754US).

Real Party in Interest

This application is assigned to DaimlerChrysler AG of Stuttgart, Germany, which is the real party in interest in this appeal.

Related Appeals and Interferences

Applicants and their counsel are not aware of any related appeals or interferences which would affect, be affected by, or have a bearing on the instant appeal.

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Status of Claims

Claims 27, 31, 32, 34-37, 39-42, 44-47, 51-56, and 58-61 are pending and under examination. Claims 27, 31, 32, 34-37, 40, 41, 44-47, 51-56, 59, and 60 are allowable. Claims 39, 42, 58, and 61 are finally rejected and form the subject of this appeal.

Status of Amendments

There are no unentered amendments.

Summary of Claimed Subject Matter

Claim 39 is directed to a vehicle frame that includes lightweight panels (18, 26, 30) having an opening (70) (specification at paragraph [0004] and Figures 1 and 3-9). The vehicle frame further includes a vehicle device (74) that is insertable into the opening (70) so as to cover the opening (70) completely (specification at paragraph [0004] and Figures 3-9). The vehicle device (74) includes a support arrangement (76) that is engageable with an edge of the opening (70) to limit the insertion of the vehicle device (74) in the opening (70) (specification at paragraph [0004] and Figure 4). The vehicle device (74) can be a steering console (specification at paragraph [0028] and Figure 6).

Claim 42 is directed to a vehicle frame that includes lightweight panels (18, 26, 30) having an opening (70) (specification at paragraph [0004] and Figures 1 and 3-9). The vehicle frame further includes a vehicle device (74) that is insertable into the opening (70) so as to cover the opening (70) completely (specification at paragraph [0004] and Figures 3-9). The vehicle device (74) includes a support arrangement (76) that is engageable with an edge of the opening (70) to limit the insertion of the vehicle device (74) in the opening (70) (specification at paragraph [0004] and Figure 4). The vehicle device (74) can be an insertion module for a windshield wiper assembly (specification at paragraph [0029] and Figure 8).

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Claim 58 is directed to a method for making a passenger vehicle assembly. The method includes the steps of providing a frame of the passenger vehicle assembly with lightweight panels (18, 26, 30) (specification at paragraph [0004] and Figures 1 and 3-9), providing an opening (70) in one of the lightweight panels (18, 26, 30) (specification at paragraph [0004] and Figures 1 and 3-9), inserting a vehicle device (74) into the opening (70) so as to cover the opening (70) completely (specification at paragraph [0004] and Figures 3-9), and engaging a support arrangement (76) of the vehicle device (74) with an edge of the opening (70) to limit the insertion of the vehicle device (74) in the opening (70) (specification at paragraph [0004] and Figure 4). The vehicle device (74) can be a steering console (specification at paragraph [0028] and Figure 6).

Claim 61 is directed to a method for making a passenger vehicle assembly. The method includes the steps of providing a frame of the passenger vehicle assembly with lightweight panels (18, 26, 30) (specification at paragraph [0004] and Figures 1 and 3-9), providing an opening (70) in one of the lightweight panels (18, 26, 30) (specification at paragraph [0004] and Figures 1 and 3-9), inserting a vehicle device (74) into the opening (70) so as to cover the opening (70) completely (specification at paragraph [0004] and Figures 3-9), and engaging a support arrangement (76) of the vehicle device (74) with an edge of the opening (70) to limit the insertion of the vehicle device (74) in the opening (70) (specification at paragraph [0004] and Figure 4). The vehicle device (74) can be an insertion module for a windshield wiper assembly (specification at paragraph [0029] and Figure 8).

As stated in the specification, the claimed invention has several advantages. For example, the claimed invention allows the mounting of vehicle devices in a space-saving and simple manner. The space created by an opening in a lightweight panel can be utilized for a vehicle device without any significant weakening of the lightweight panel. In contrast to conventional methods of mounting a vehicle device, the claimed invention does not require additional reinforcement. The arrangement of a vehicle device in a lightweight panel

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defining the passenger area inside the vehicle is especially advantageous, because the space available for vehicle devices in that area is very limited. In the area around the opening, the lightweight panel can be easily reinforced with the vehicle device's support arrangement, such as a mounting flange.

Ground of Rejection to Be Reviewed on Appeal

Claims 39, 42, 58, and 61 were rejected under 35 U.S.C. §102(b) as being anticipated by Simonetti (U.S. Patent 5,813,288).

Argument

Claims 39, 42, 58, and 61 were rejected under 35 U.S.C. §102(b) as being anticipated by Simonetti (U.S. Patent 5,813,288).

Background

In the final Office Action dated February 12, 2004, the Examiner rejected Claims 39, 42, 58, and 61 under 35 U.S.C. §102(b) as being anticipated by Simonetti (U.S. Patent 5,813,288).

As described at column 2, lines 17-42, Simonetti discloses a steering column (20) that projects through an opening (22) in the instrument panel (24) of a vehicle (Figure 11). The steering column (20) is pivotably mounted at a point designated by reference numeral 32 for up and down movement of the steering wheel (Figures 2 and 12). The opening (22) is large enough to allow for full travel and tilt of the steering column (20). In order to seal and close the space between the opening (22) and the steering column (20), a boot (40) is provided. The boot (40) is made of a flexible elastomeric material, such as natural or synthetic rubber.

In the final Office Action dated February 12, 2004, the Examiner stated:

Simonetti discloses a vehicle frame comprising light weight panels (#24; others not shown) having an opening (#22) and a vehicle device (#30) insertable into the opening so as to cover the opening

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completely (best seen in figures 1, 2), the vehicle device including a support arrangement (#30, 46) that is engageable with an edge of the opening in the light weight panel to limit insertion of the vehicle device in the opening (best seen in figure 2, 11).

In the Reply filed May 4, 2004, Applicants disagreed with the Examiner's reading of Simonetti, pointing out that Figure 11 of Simonetti clearly shows that the housing (30), which according to the Examiner is a vehicle device, does not cover the opening (22) in the instrument panel (24). In fact, Applicants pointed out that, if the housing (30) did cover the opening (22), the steering column would not be able to pivot, and the steering wheel (26) would not be able to move up and down, as described in Simonetti.

Applicants also disagreed with the Examiner contention that Simonetti discloses "a support arrangement (#30, 46) that is engageable with an edge of the opening in the light weight panel to limit insertion of the vehicle device in the opening." Applicant stated that Figure 11 of Simonetti clearly shows that the housing (30) and its annular flange (46) do not and cannot contact, let alone engage with, the edge of the opening (22) in the instrument panel (24). Furthermore, Applicants pointed out that the flexible elastomeric boot (40) of Simonetti, which is provided between the opening (22) and the steering column (20) (see Simonetti at Figure 11 and column 2, lines 30-32), cannot limit the insertion of the steering column (20) in the opening (22).

In the Advisory Action dated June 24, 2004, the Examiner maintained the rejection of Claims 39, 42, 58, and 61. Although it was unmistakable that in the final Office Action the Examiner referred to the opening (22) of Simonetti when she stated that Simonetti discloses an opening, the Examiner now contended that she was referring to the opening that is located within the inner wall (#42). In other words, the Examiner now contended that the opening of Simonetti is defined by the inner wall (42) of the flexible elastomeric boot (40).

Applicants' counsel then telephoned the Examiner for a clarification. Applicants' counsel pointed out that the Examiner clearly did not state in the

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final Office Action that the area defined by the inner wall (42) of the flexible elastomeric boot (40) was the opening when she stated that Simonetti discloses an opening. Applicants' counsel also repeated Applicants' arguments in the Reply to the final Office Action that the flexible elastomeric boot (40) of Simonetti cannot limit the insertion of the steering column (20), because the boot (40) is flexible and because the axial position of the steering column (20) is already fixed by the pivotable connection at its lower end. Therefore, the insertion of the steering column (20) into the opening is not, and cannot be, limited by anything else, let alone the flexible elastomeric boot (40). After the Examiner insisted that the flexible elastomeric boot (40) limits the insertion of the steering column (20), Applicants' counsel asked the Examiner to point out a position which the steering column (20) can reach without the flexible elastomeric boot (40) but cannot reach with the flexible elastomeric boot (40). The Examiner did not provide a response.

The Examiner's Interview Summary dated July 8, 2004 gives the impression that in the interview she stated that a portion of Claim 39 recites the intended use of the apparatus, and Applicants' counsel did not offer any response. Applicants' counsel is compelled to state that he simply does not recall that the Examiner made that statement. And if that statement had been made in the interview, Applicants' counsel would certainly have pointed out that the statement was incorrect.

With regard to Claims 39, 42, 58, and 61, the Examiner is in error in contending that in Simonetti both the housing (30) covers completely the opening (22) and the flange (46) of the housing (30) is engageable or engages with the edge of the opening to limit the insertion of the housing (30) into the opening (20), because as shown in Figure 11 of Simonetti the opening (20) is larger than the housing (30)

Each of Claims 39 and 42 recites a support arrangement that is engageable with an edge of the opening to limit the insertion of the vehicle device in the opening. And each of Claims 58 and 61 recites the step of engaging a

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support arrangement of the vehicle device with an edge of the opening to limit the insertion of the vehicle device in the opening.

In the final Office Action, the Examiner contended:

Simonetti discloses a vehicle frame comprising light weight panels (#24; others not shown) having an opening (#22) and a vehicle device (#30) insertable into the opening so as to cover the opening completely (best seen in figures 1, 2), the vehicle device including a support arrangement (#30, 46) that is engageable with an edge of the opening in the light weight panel to limit insertion of the vehicle device in the opening (best seen in figure 2, 11) (emphasis added).

Applicants disagree with the Examiner's reading of Simonetti, because for any one of the following three reasons the housing (30) and its annular flange (46) do not and cannot contact, let alone engage with, the edge of the opening (22) to limit the insertion of the housing (30) into the opening (20). First, Figure 11 of Simonetti clearly shows that the housing (30), which according to the Examiner is a vehicle device, does not cover the opening (22). In fact, if the housing (30) did cover the opening (22), the steering column would not be able to pivot, and the steering wheel (26) would not be able to move up and down, as described in Simonetti. Second, as shown in Figure 11, the housing (30) and its annular flange (46) cannot cover the opening (22) because the opening (20) is larger than the housing (30) and its annular flange (46). Third, the housing (30) and its annular flange (46) do not limit the insertion of the housing (30) into the opening (20) because the steering column (20) is already fixed in its longitudinal direction as it is pivotably mounted at its lower end.

Therefore, the Examiner's rejection, as set forth in the final Office Action, was improper, because Simonetti does not disclose a support arrangement that is engageable or engaged with an edge of the opening to limit the insertion of the vehicle device in the opening.

With regard to Claims 39, 42, 58, and 61, the Examiner is in error in contending that the boot (40) of Simonetti limits the insertion of the housing (30) into the

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opening in the boot (40), because the boot (40) is made from a flexible elastomeric material, and/or because the steering column (20) is connected pivotably at its lower end (32) to the vehicle frame

In the Advisory Action dated June 24, 2004, the Examiner maintained the rejection of Claims 39, 42, 58, and 61. Although it was unmistakable that in the final Office Action the Examiner referred to the opening (22) of Simonetti when she stated that Simonetti discloses an opening, the Examiner now contended that she was referring to the opening that is located within the inner wall (#42). In other words, the Examiner now contended that the opening of Simonetti is defined by the inner wall (42) of the flexible elastomeric boot (40).

Aside from the issue of whether this new rationale for the rejection is properly and timely presented, the flexible elastomeric boot (40) of Simonetti simply does not and cannot limit the insertion of the steering column (20) in the opening (22). First, the flexible elastomeric boot (40) of Simonetti cannot limit the movement of the steering column (20) because the boot (40) is flexible. If the Examiner insists that the flexible elastomeric boot (40) limits the insertion of the steering column (20), she is invited to point out a position which the steering column (20) can reach without the flexible elastomeric boot (40) but cannot reach with the flexible elastomeric boot (40). Second, the axial position of the steering column (20) is fixed by the pivotable connection at its lower end. Therefore, the insertion of the steering column (20) into the opening (22) is not, and cannot be, limited by the flexible elastomeric boot (40).

Therefore, the Examiner's rejection, as set forth in the Interview Summary, was improper, because the flexible elastomeric boot (40) of Simonetti does not and cannot limit the insertion of the steering column (20) into the opening (22).

With regard to Claims 39, 42, 58, and 61, the Examiner is in error in contending that that the opening of Simonetti that is defined by the inner wall (42) of the flexible elastomeric boot (40) is equivalent to the opening in the lightweight panels

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of claims 39, 42, 58, and 61, because the flexible elastomeric boot (40) is not a lightweight panel of a vehicle frame

Each of Claims 39 and 42 recites lightweight panels of a vehicle frame that have an opening. And each of Claims 58 and 61 recites a method that includes the step of providing an opening in one of the lightweight panels of a vehicle frame.

In the Advisory Action, the Examiner contended that the opening of Simonetti that is defined by the inner wall (42) of the flexible elastomeric boot (40) is equivalent to the opening in the lightweight panels of claims 39, 42, 58, and 61. In effect, the Examiner contended that the flexible elastomeric boot (40) of Simonetti is a lightweight panel of a vehicle frame.

The Examiner's contention is clearly erroneous because the flexible elastomeric boot (40) of Simonetti is not a lightweight panel of a vehicle frame. First, a principal teaching of Applicants' invention is the mounting and securing of a vehicle device in the lightweight panels of a vehicle frame (see specification at paragraphs [0026] and [0027]). Based on this teaching, a person with ordinary skill in the art would not consider the flexible elastomeric boot (40) of Simonetti as a lightweight panel of a vehicle frame, because a vehicle device cannot be mounted and secured on the flexible elastomeric boot (40) of Simonetti.

Additionally, Simonetti itself does not consider the flexible elastomeric boot (40) as a lightweight panel of a vehicle frame. Simonetti does disclose an instrument panel of the vehicle support structure, which is designated by reference numeral 24. The flexible elastomeric boot (40) is not considered part of the instrument panel (24) and is merely a part that is secured to the instrument panel (24) (column 8, lines 17-24).

Therefore, the Examiner's rationale for the rejection, as set forth in the Interview Summary, is improper, because the flexible elastomeric boot (40) of Simonetti is not a lightweight panel of a vehicle frame.

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The Examiner's contention in the Interview Summary that the language of Claim 39—"a support arrangement that is engageable with an edge of the opening to limit the insertion of the vehicle device in the opening"—leads to the intended use of the apparatus, is erroneous

In the Interview Summary dated July 8, 2004, the Examiner contended that a portion of Claim 39 leads to the intended use of the apparatus, the portion being the claim language—"a support arrangement that is engageable with an edge of the opening to limit the insertion of the vehicle device in the opening." The Examiner failed to say, and it is not clear to Applicants, what the significant of this statement is. Is this statement meant to support the rejection? If it is, how does it support the rejection? Why does the cited claim language lead to intended use?

The Examiner's statement, if meant to support the rejection, constitutes a new ground of rejection, because the statement is made in an Interview Summary issued after a final Office Action and Applicants have not been given fair opportunity to react to the thrust of the rejection. *In re Kronig*, 539 F.2d 1300, 190 USPQ 425 (CCPA 1976). Applicants are not aware any provision in the MPEP or patent rules that authorizes the Examiner to provide a new ground of rejection in an interview summary issued after a final Office Action.

Additionally, if the statement is meant to support the rejection, it is improper because it does not meet the requirements of the Manual of Patent Examining Procedure (MPEP). The MPEP requires that the Examiner properly communicate the basis for a rejection so that Applicant can be given fair opportunity to reply. *MPEP* §706.02(j). The MPEP further requires that where a claim is refused for any reason relating to the merits thereof the ground of rejection should be fully and clearly stated. *MPEP* §707.07(d). In the present case, the Examiner did not fully and clearly state the basis for the rejection.

Furthermore, it is not clear to Applicants, and the Examiner did not explain, how this claim language can be said to lead to the intended use of an

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apparatus. The cited claim language defines the structural relationship between two components (the vehicle device and the opening) of the claimed vehicle frame. Specifically, it defines the interaction and physical relationship between the two components.

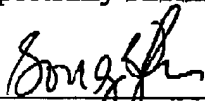
Conclusion

For the foregoing reasons, the rejection of Claims 39, 42, 58, and 61 under 35 U.S.C. §102(b) as being anticipated by Simonetti is in error, and the Board is respectfully requested to reverse the rejection.

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response, and please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323 (Docket #095309.50754US).

January 11, 2005

Respectfully submitted,



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Serial No. 10/043,277

Attorney Docket: 095309.50754US

Claims Appendix

The claims on appeal read as follows:

39. (previously presented) A vehicle frame comprising:

lightweight panels having an opening; and

a vehicle device insertable into the opening so as to cover the opening completely, the vehicle device including

a support arrangement that is engageable with an edge of the opening to limit the insertion of the vehicle device in the opening, wherein the vehicle device is a steering console.

42. (previously presented) A vehicle frame comprising:

lightweight panels having an opening; and

a vehicle device insertable into the opening so as to cover the opening completely, the vehicle device including

a support arrangement that is engageable with an edge of the opening to limit the insertion of the vehicle device in the opening, wherein the fitting is an insertion module for a windshield wiper assembly.

58. (previously presented) A method for making a passenger vehicle assembly comprising:

providing a frame of the passenger vehicle assembly with lightweight panels;

providing an opening in one of the lightweight panels;

inserting a vehicle device into the opening so as to cover the opening completely; and

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engaging a support arrangement of the vehicle device with an edge of the opening to limit the insertion of the vehicle device in the opening, wherein the vehicle device is a steering console.

61. (previously presented) A method for making a passenger vehicle assembly comprising:

providing a frame of the passenger vehicle assembly with lightweight panels;

providing an opening in one of the lightweight panels;

inserting a vehicle device into the opening so as to cover the opening completely; and

engaging a support arrangement of the vehicle device with an edge of the opening to limit the insertion of the vehicle device in the opening, wherein the vehicle device is an insertion module for a windshield wiper assembly.

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